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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,857	12/30/2003	Randall Cornfield	ICS-handle	6240
7590	03/03/2009	DAN M. DE LA ROSA, Esq. 300 EAST 77th STREET, SUITE 24C NEW YORK, NY 10075	EXAMINER WILLIAMS, MARK A	
			ART UNIT 3673	PAPER NUMBER
			MAIL DATE 03/03/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/748,857	CORNFIELD, RANDALL
	<b>Examiner</b>	<b>Art Unit</b>
	MARK A. WILLIAMS	3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 November 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 45-64 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 45-64 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 45-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 45, 55, and 64, the phrase “said tapered front side and said tapered rear end are situated on said axis on the center of said body” is unclear and not fully understood in the context of the claim language. How and by what precise structure is this achieved.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 45-47 and 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron et al., US Design Patent Des. 295,011, in view of Mosley, US Design Patent Des.397,018.

Herron provides a handle implement comprising an elongated body having a front side and a tapered rear end, top and bottom surfaces and opposing sides, said body being generally rounded and being generally parallel to a longitudinal axis at the center of said body, as best understood, said tapered front side and said tapered rear end are situated on said axis at the center of said body; a thumb positioning section situated on said top surface of said body adjacent to said front side of said body, said thumb positioning section comprising a concave indentation, said thumb positioning section sloping downwardly from said indentation towards said opposing sides of said body, said thumb positioning section comprising a thumb rest section; and an index finger rest section situated on said bottom surface of said body adjacent to said front side of said body, said index finger rest section comprising a cavity with an extended protrusion, said protrusion designed to cover at least a portion of user's index finger. An encirclable section situated adjacent said rear end of said body, said section being generally rounded in its circumference. The encirclable section is designed to support user's palms and three fingers. The thumb positioning section is situated above said index finger

rest section. An aperture situated adjacent said rear end of said body. The thumb rest section is recessed relative to said thumb positioning section. The thumb rest section protrudes relative to said thumb positioning section. The tapered front and rear ends extend outwardly toward one another and then tapers adjacent said index finger rest section. The tapered front and rear ends extend outwardly toward one another and then tapers adjacent said thumb positioning section.

Herron provides the claimed invention except explicitly teaching (1) both a tapered front side and a tapered rear end, as claimed; (2) the tapered front and rear ends extend outwardly toward one another and then tapers adjacent said index finger rest section; (3) the tapered front and rear ends extend outwardly toward one another and then tapers adjacent said thumb positioning section; and (4) the thumb rest section is constructed of a different material relative to said body and said thumb positioning section.

Regarding (1)-(3), Mosley teaches these general concepts in a particular handle design. Such a design creates a particular visual appearance that may be desired. In addition, one skilled in the art would know that the particular indentation shape provides additional shielding to the finger of a user. It would have been obvious to include such modifications in the design of Herron for the

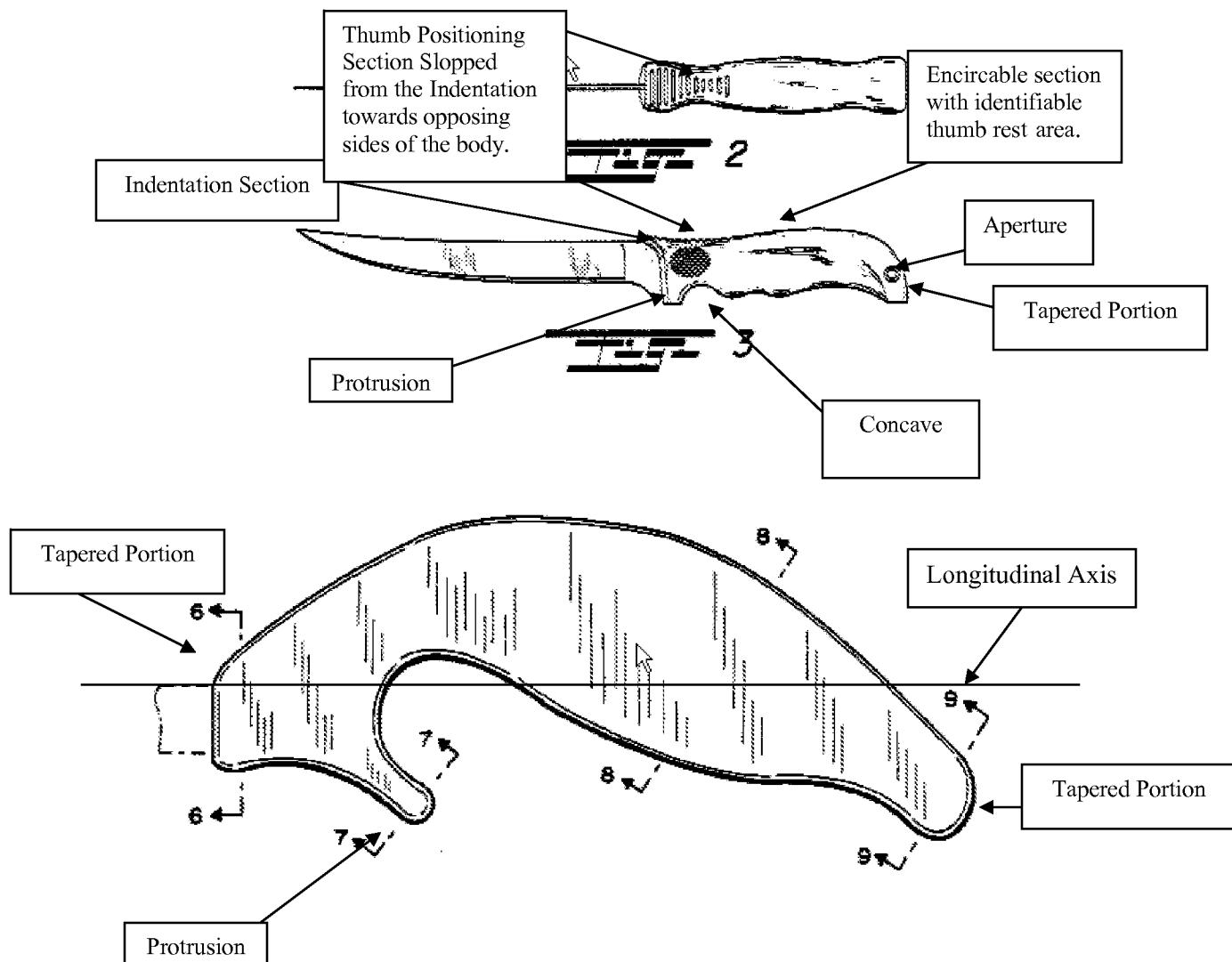
purpose of achieving a particular visual appearance of the handle as well as additional shielding means for a user's finger during use of the knife.

Regarding (4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in this way, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. Such a modification would have produced no unexpected results, and is not novel. On advantage to such a modification is that such a material would add in the gripping of the device.

3. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herron et al. in view of Mosley, in further view of Garon, US Design Patent D476,535S.

The combination provides the claimed invention except explicit teaching of a rim as claimed. However, such rim structure is old and well known in the art. Garon provides a general example of a rim structure at a thumb positioning portion. Such structure is known for providing additional surface against slippage of a user's

thumb, as well as may have also added to the aesthetic appeal of the device. It would have been obvious at the time the invention was made for one skilled in the art to have modified the invention in this way, for the purpose of providing additional surface against slippage of a user's thumb; as well as also adding to the aesthetic appeal of the device.



***Response to Arguments***

4. Applicant's arguments filed 11/24/08 have been fully considered but they are not persuasive.

Applicant argues that the examiner has agreed in an in person interview of 11/13/08 that the applied art does not disclose aspects of the claimed invention. However, this is not the case. The examiner agrees that there are distinctions between applicant's disclosed invention, as provided in the specification and drawings, and the applied art. However, applicant's claim language is substantially broad to the extent that each limitation can be at least broadly met by the applied art, in combination. The examiner is required to give the broadest reasonable interpretation of the claim language. Thus the rejection is considered appropriate and is maintained.

Applicant argues that Herron does not provide the claimed tapped front side and tapered rear end situated on the axis, as claimed. The examiner considers Herron to provide a rear end tapered portion, but does not explicitly show a front side tapered portion, as claimed. The combination of Mosley with Herron would provide this limitation of a tapped front end portion, as outlined in the above rejection. As best understood, the end portion and the front portion can be at least arbitrarily selected along the body so as to at least partly fall along part of this axis,

thus meeting the claim language. Note that the front and rear end portion, as well as the precise location of the axis, are not considered to be distinctly claimed, thus can not be fully determined in the context of the claimed invention.

Applicant argues that Herron does not provide a thumb positioning section with a concave indentation and the thumb positioning section sloping downwardly from the indentation towards the opposing side of the body. The examiner disagrees, since such limitations can be read into the figure of Herron. See above attached figure. Looking closely at both figures 2 and 3, Herron can be interpreted to provide at least a minimum amount of sloping from the thumb position section to opposing sides of the body (note the lines in the drawings used to represent curved regions, as conventional in mechanical drawings and the like). Applicant has not sufficiently amended the claims to overcome the applied art of record.

Applicant argues that the elongated body of Herron does not include encirclable section situated adjacent the rear end of the body, and is not provided as being generally round, as claimed. However, it is the position of the examiner that this handle body of Herron can broadly be considered as having an encirclable section and being generally rounded, because of its curved shape. (Applicant should note also that even if it were determined that Herron does not provide such a rounded shape as claimed, an obvious combination of Herron with Mosley would

provide such rounded shape, clearly meeting the claimed limitations; such a modification is not considered novel and would have been obvious to one skilled in the art, as least for aesthetic appeal.)

Applicant argues that the applied art does not provide "tapered front and rear ends extend outwardly toward one another and then tapers adjacent said thumb position section" and/or "“said index finger rest section”. However, the combination of the applied art provides such structure, especially when considering the general shape of Mosley.

Applicant argues that Herron and Mosley are not combinable because they teach away from one another. The examiner disagrees. The combination of Mosley into Herron would provide a similarly functioning handle with added features to the design producing a particular smooth, more rounded shape, that would have at least created a particular visual appeal, but not substantially modifying the function of the device. Thus the rejection is still considered proper.

Applicant argues that there is no motivation to combine Herron and Mosley as applied, and that the handles are intended to be used differently. However, it is the position of the examiner being that both handles are knife handles and intended to be used in the same applications, to borrow particular features from one handle so as to be added to the aesthetic appeal, as well as utility, of the other handle is

obvious, as outlined in the above rejection. One skilled in the art may have the motivation to combine Heron and Mosley for the purpose of achieving a particular visual appearance of the handle as well as additional shielding means for a user's finger during use of the knife.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is

(571) 272-7064. The examiner can normally be reached on Monday through Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark A. Williams/  
Examiner, Art Unit 3673

/Patricia L Engle/  
Supervisory Patent Examiner,  
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